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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,257	02/22/2002	Jeffrey W. Mankoff	24124721.000008	2774
23562 7590 11/14/2008 BAKER & MCKENZIE LLP PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201				
EXAMINER CHAMPAGNE, DONALD				
ART UNIT 3688		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/081,257

Applicant(s)

MANKOFF, JEFFREY W.

Examiner

Donald L. Champagne

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-90 is/are pending in the application.
- 4a) Of the above claim(s) 72-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 53-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At claim 53 limitation "c)", "identifying the first incentive associated with the first received virtual document" is new matter. The spec. does not disclose any distinction between "virtual documents" and incentives. Indeed, para. [0042] is typical of the published application (US 20020120627A1) in identifying incentives (*merchant coupons, rebates*)¹ as kinds of virtual documents.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 53-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The distinction between "first distribution partner/business advertiser" (e.g., claim 53 limitations "b)" and "c)") and "second distribution partner/business advertiser" (e.g., claim 53 limitations "e)" and "f)") is indefinite.
5. The claimed distinction between first and second distribution partners/business advertisers is interpreted to be based on ownership. Ownership is inherently indefinite because it is not concrete (predictable). The US Supreme Court has ruled that "A corporation is an artificial being, invisible, intangible and existing only in contemplation of law." *CTS Corp. v. Dynamics Corp. of America*, 481 U.S. 69, 89, 107 S. Ct. 1637, 1649-1650 (1987) (citing

¹ The word "incentive" does not appear in the published application but is acceptable as a genus name for the several kinds of incentives (e.g., *merchant coupons*) that are disclosed therein.

Art Unit: 3688

Trustees of Dartmouth College v. Woodward, 17 U.S. (4 Wheat) 518 (1819)). An enterprise can be created, merged, dispersed or destroyed at human whim. Hence, in accordance with the *State Street* decision (MPEP 2106.II.A), ownership limitations cannot impart patentability.

6. Assume that a patent was granted with the claims limited to "a first business advertiser" different from "a second business advertiser". What would happen if one of these two entities bought the other? Does the patent suddenly become invalid? Further, does the patent regain its validity if the merged company is later broken up? And, what would happen is some third entity bought 50% of each the "first business advertiser" and the "second business advertiser"? Would the two business advertisers now be "half different"?
7. The limitation, "unassociated with the network database" (e.g., claim 53 at the end of limitations "b)", "c)", "e)" and "f)") is indefinite: What is unassociated with the network database? For present purposes of examination, it is assumed that it is the "first/second distribution partner/business advertiser" which is unassociated with the network database. That assumption appears to be supported by para. [0011] or [0054] in the published application (US 20020120627A1).

Claim Rejections - 35 USC § 102 and 35 USC § 103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 53-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US006915271B1).

10. Meyer et al. teaches (independent claim 53) a method of managing virtual documents (*promotional incentives*)² associated with one or more enterprises on behalf of a plurality of consumers, wherein a given virtual document comprises data associating it with one of the consumers and with one of the business advertisers, the method comprising:

a) establishing a network database (*member database 111*, col. 18 lines 35-38) on a network-connected computer (*member information computer 109*) said network database corresponding to a plurality of consumers, the network database having data records including a set of categories (col. 21 lines 37, and also *consumer factors* and *characteristics of the viewing consumer*, col. 6 lines 42 and 49-50);

b) receiving a first one of said virtual documents (*one or more Web pages*, col. 10 lines 43-53) at said network-connected computer from a document providing server (col. 19 lines 56-60) in response to a consumer's first incentive selection (col. 17 lines 60-67), the first virtual document having an attribute file identifying a classification (*types of offers* and *categories*, col. 39 lines 56-61 and Fig. 31) for the first virtual document (the Fig. 31 web page);

c) identifying the consumer corresponding to the first received virtual document (col. 21 lines 18-37) and identifying the first incentive (any of the *clipped incentives*, col. 39 lines 56-60) associated with the first received virtual document;

d) storing information regarding the first received virtual document within first data fields in a record associated with the identified consumer (col. 36 lines 65-67), wherein the first data fields include a first business identifier value indicating the first business advertiser (col. 23 lines 14-15) and first incentive information indicating the first incentive (col. 21 lines 18-37);

e), f) and g): respectively repeating steps a), b) and c) for a second virtual document/web page (e.g., at the *Circuit City's Web site*, col. 16 lines 60-67) with a second incentive (any *clipped incentive* other than the first);

h) categorizing the first and second virtual documents in the categories of the data record associated with the identified consumer according to the classifications provided in the attribute files of the first and second virtual documents (col. 39 lines 56-61 and Fig. 31).

² Meyer et al. uses this phrase as well as *promotion* and *incentive* interchangeably, although Meyer et al.

Art Unit: 3688

11. The following language in claim 53 is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01).

"provided to a first/second distribution partner distributing the first/second incentive and unassociated with the network database"; and

"identifying a first/second business advertiser associated with the first/second received virtual document and the first/second incentive but unassociated with the network database".

In the sense used in the patent law (35 USC 101), a "distribution partner/business advertiser" is not functional because it is neither "tied to a particular apparatus" nor "operates to change materials to 'a different state or thing'" (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).

12. Meyer et al. also teaches at the citations given above claims 54, 55, 59 (where the clipping process reads on emailing), 60, 61, and 69-71.
13. Meyer et al. also teaches claims 56-58 (col. 7 lines 39-46); claims 62-66 (col. 5 lines 19-26 and col. 17 line 60 to col. 18 line 6); and claims 67 and 68 (col. 43 lines 58-62 and col. 44 lines 9-15).

Response to Arguments

14. Applicant's arguments filed with an amendment on 22 August 2008 have been fully considered but they are not persuasive. Applicant argues (p. 12 of 15) that the claims have been perfected to overcome the rejection under 35 USC 112, second para. The examiner does not wholly agree. The replacement of "enterprise" with "distribution partner" and "business advertiser" is merely a change in words without patentable substance. Applicant also argues that an "advertiser" "in many cases is an individual" person, but "in many cases" is hardly a patentable limitation even if it were supported by the specification. Furthermore, "advertiser" literally interpreted as a human being rather than as a business entity would not be patentable (last para. of MPEP § 2105). The comments with respect to the previous rejection under 35 USC 102(e) have been addressed by the above revision of that rejection.

does also describe an *incentive* as a component of a *promotion*, col. 16 lines 17-18.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
18. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
20. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be

Art Unit: 3688

accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words.

Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

21. Applicant may have after final arguments considered and amendments entered by filing an RCE.
22. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).
23. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

10 November 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688